UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ELIZABETH M. DENHOLM, ELIZABETH CAUCHON, and PAUL J. SILVER

Appeal No. 2005-2236
Application No. 09/727,873

ON BRIEF[1]

Before, SCHEINER, ADAMS and MILLS, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The claims on appeal from the examiner's final rejection are claims 1-11, which are all of the claims pending in this application.

Claim 1 is representative of the claims on appeal and appears as set forth below.

1. A method to decrease fibrous tissue size comprising administering to an

[1] This Application was originally scheduled for oral hearing on October 18, 2005. Upon review of the application, this merits panel has determined that an oral hearing at the present time is inappropriate, and thus has remanded the application to the examiner.

individual in need of treatment thereof an effective amount of a dermatan sulfate or chondroitin sulfate degrading enzyme to decrease fibrous cell proliferative response to growth factors, reduce secretion of collagen by fibroblasts, and thereby decrease the size of the fibrous tissue.

The prior art references relied upon by the examiner are:

Triscott	5,985,582	Nov. 16, 1999
Yacoby-Zeevi (Yacoby)	6,153,187	Nov. 28, 2000

Grounds of Rejection

Claims 1-11 stand rejected under 35 U.S.C. §103 as obvious over Yacoby taken with Triscott.

DISCUSSION

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we vacate[2] the examiner's rejection and remand the application to the examiner to consider the following issues and take appropriate action.

1. What has been examined in this application?

On this record, there is a substantial amount of confusion as to what has been

[2] The term "vacate," as applied to an action taken by an appellate tribunal, means to set aside or void. Black's Law Dictionary 1075 (abridged 6th ed. 1991). When the board vacates a rejection and remands the application to the examiner, that rejection no longer exists, the appeal is ended and jurisdiction over the application on appeal is returned to the examiner for further action not inconsistent with the views expressed in the opinion accompanying the board's decision. The board does not take an ultimate position on the correctness of an examiner's rejection when that rejection is vacated. See also Ex parte Zambrano, 58 USPQ2d 1312 (Bd.Pat.App. & Int. 2001).

examined in the application. The record reflects that a restriction requirement was made in the application between claims to a method of using an enzyme and claims to an enzyme composition. Paper No. 2, pages 2-3. Appellants elected to prosecute the method claims and cancelled composition claims 12-19. Paper dated Dec. 1, 2000, page 2.

In addition to the restriction requirement, an election of species was also made in the application for claims 1-11. According to the record, appellants elected "organ fibrosis as the disorder and chondroitinase B as the enzyme."[3] Paper No. 2, page 3 and Paper dated Dec. 1, 2000, page 2.

The examiner indicates on page 6 of the Answer that, "the examination was limited to organ fibrosis" and that, "[s]ince organ fibrosis is being treated and not skin disorders then one would administer the enzyme as an inhaler as taught by the reference. Appellants claims to topical application would not apply. Controlled or sustained release formulations are what an inhaler provide." The examiner further argues on page 3 of the Answer that cystic fibrosis encompasses "organ fibrosis since cystic fibrosis affects among other parts of the body, the lungs."

However, the examiner also agreed with the Appellants that the status of the claims pending in the application as filed with the Brief, and the copy of the claims on appeal in the Brief was correct. Answer, page 2. The claims filed with the Brief, include claims to skin disorders (claim 6) and specific skin disorders (claim 7).

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[3] Note, however that it was the original composition (formulation) claim 12 that recited a disorder involving "organ fibrosis" which is nowhere mentioned in original method claim 1 or amended method claim 1.

Thus it is unclear from statements made in the Answer, whether the Examiner actually searched and examined subject matter related to skin disorders. Furthermore, appellants appear to have argued claim 7 separately from the other claims, and it is unclear whether the examiner actually searched skin disorders such as scleroderma or psoriasis. Moreover, the skin of the body is considered a body organ, – would it therefore be considered a subgroup of "organ fibrosis".

It would appear from the record that the examiner has only examined the lung as the organ which is the object of "organ fibrosis" or "pulmonary fibrosis" (claim 8). However, the election made by appellants was to "organ fibrosis" and was not limited to lung or "pulmonary fibrosis". The election does not appear to exclude skin as an organ.

The application is remanded to the examiner to clarify the subject matter and claims that have been searched in the application. The examiner should indicate whether skin disorder claims are properly before us on appeal. If they are not, the examiner should so indicate. If the skin disorder claims are before us on appeal because the skin is an organ and "organ fibrosis" was elected by the appellants, the examiner should indicate whether these claims are rejected. The examiner's attention is also directed to 37 C.F.R. § 1.141 discussing the examination of different inventions in one application, and in particular, to the examination of a reasonable number of species of a generic invention.

2. Has the Reply Brief been entered and considered?

It also appears there has been significant confusion relating to papers in this appeal file and that the file had to be reconstructed at some point. Reply Brief, page 1.

In a communication dated April 5, 2005, the examiner noted that a Reply Brief had been filed in the application. The examiner failed to state whether the Reply Brief was entered and considered. The examiner failed to indicate in the Answer whether the evidence attached to the Reply Brief was considered.

The application is remanded to the examiner to determine and state whether the Reply Brief, and the evidence attached thereto, was entered and considered. In particular, if the Reply Brief was entered by the examiner, the examiner must respond to arguments of the Appellants in the Reply Brief that cystic fibrosis is not the same as "pulmonary fibrosis". The examiner states in the Answer at page 5 that "since the reference treats cystic fibrosis then by definition they will treat a pulmonary fibrosis." The examiner provides no evidence to support this position. If the examiner continues this line of reasoning, the examiner must provide evidence that the condition of cystic fibrosis involves or encompasses a condition defined as "pulmonary fibrosis."

The examiner should also indicate and address whether claims to topical application have been examined in the application, as they appear to have been separately argued by appellants.

Finally, after the examiner has clearly indicated what claims are on appeal and whether they have been properly searched, the examiner should take a step back and determine whether the prior art is properly applied to the pending claims. In particular,

it should be noted that Yacoby appears to teach that chondroitinase B and C from *Flavobacterium heparinum* are known in the art. Col. 5, lines 33-35. Thus, Triscott would appear to be cumulative to the disclosure of Yacoby.

CONCLUSION

The application is remanded to the examiner for reconsideration of the issues discussed herein.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is ***not*** made for further consideration of a rejection that is

pending, as the rejection before us has been vacated. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

REMANDED

TONI R. SCHEINER
Administrative Patent Judge

DONALD E. ADAMS
Administrative Patent Judge

DEMETRA J. MILLS
Administrative Patent Judge

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